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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHYLLIS LEITHEM,
CHARLES A. KREMERS, W. PAUL HARRELL,
STEPHEN LEWIS, KARL D. SEARS,
QUAN HE, and PETER R. ABITZ
APPELLANTS

Appeal 2008-0222
Application 09/863,585
Technology Center 3700

Decided: September 4, 2008

Before SALLY GARDNER LANE, MICHAEL P. TIERNEY, and
JAMES T. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the second rejection of claim 104. Claims 1-103 and 105-150 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

STATEMENT OF THE CASE

This appeal is concerned with absorbent products with fluffed cellulose absorbent centers. Such absorbent products are , e.g. adult sanitary garments for preventing accidental excretory discharge. The absorbent material is cold caustic extracted and fluffed.

Claim 104, the only pending claim, stands rejected under 35 U.S.C. §103 over Pociluyko and Novak.

Claim 104 reads as follows, with the required indenting added (see 37 CFR §1.75(i)):

104. An absorbent personal hygiene device comprising:

- a layer that allows liquids to pass,

- a water barrier sheet,

- an absorbent core interposed between said layer and said sheet,

- the absorbent core containing

 - at least about 25% of fluffed wood fiber pulp,

- wherein said fluffed wood fiber pulp comprises

 - wood fiber pulp that has been cold caustic extracted
and fluffed by mechanical action
and is without chemical crosslinking.

(Paragraphing added, see 37 CFR §1.75(i)).

EVIDENCE

Novak	2,083,575	Jun. 15, 1937
Pociluyko	3,658,064	Apr. 25, 1972

ISSUES

Has the Appellant established that the Examiner erred in determining that the subject matter of claim 104, specifically the use of a known wood fiber pulp that has been cold caustic extracted, fluffed by mechanical action, and is without chemical cross linking, in a conventional sanitary product, would have been obvious to one of ordinary skill in the art at the time the invention was made in view of Novak and Pociluyko?

ANALYSIS

I. Findings of Fact.

FF-01. Claim 104 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Pociluyko and Novak

FF-02. Claim 104 reads as follows:

An absorbent personal hygiene device comprising:

a layer that allows liquid to pass,

a water barrier sheet,

an absorbent core interposed between said layer and said sheet,

the absorbent core containing at least about 25% of fluffed
wood fiber pulp,
wherein said fluffed wood fiber pulp comprises
wood fiber pulp that has been cold caustic extracted and
fluffed by mechanical action and
is without chemical crosslinking. (Paragraphing added).

FF-03. Pociluyko describes a disposable absorbent diaper pad.
(1:8-9).

FF-04. Pociluyko describes that the pads have a facing sheet of
nonwoven fabric 51. (4:25; Figs. 6 and 7).

FF-05. The Examiner has found that this top sheet is a fluid
permeable layer. (Rejection, June 25, 2004, page 3, lines 5-6).

FF-06. Pociluyko describes a diapering garment having a body
of a waterproofed sheet material 10. (2:27-28; Figs. 6 and 7).

FF-07. The Examiner has found that this waterproofed sheet
material is a substantially fluid impermeable backsheet layer. (Rejection,
June 25, 2004, page 3, lines 5-6).

FF-08. Pociluyko describes a sublayer material 50 between the top
sheet layer and the backsheet layer (4:20-27; Figs. 6 and 7).

FF-09. Pociluyko describes that this sublayer material 50 between the top sheet layer and back sheet layer is made of fluffed material. (4:28).

FF-10. Pociluyko describes that the fluff material may preferably be any of a variety of fluffed wood pulp. (4:46-47).

FF-11. Pociluyko is silent as to the specific method of manufacture of wood pulp.

FF-12. The Appellant has not substantially challenged any of FF-1-11, which indicate that Pociluyko describes all of the elements of claim 104 but for the cold caustic extraction .

FF-13. Novak describes the manufacture of paper which is absorbent and easily saturated, capable of taking on more saturation than would be possible with ordinary kraft paper. (Novak, p. 2, col. 1, ll. 15-20)

FF-14. The Examiner has found that, having these soft and absorbent characteristics, Novak is suitable for use in personal hygiene articles.
((Rejection, June 25, 2004, page 3, lines 12-14).

FF-15. Novak describes a method of modifying pulp to produce an absorbent paper. (Page 1, col. 1, ll. 33-34).

FF-16. Novak's method includes soaking ordinary sheets of cellulose pulp in a caustic soda solution, causing them to become saturated. (Page 1, col. 1, ll. 34-41).

FF-17. Upon saturation, Novaks sheets swell, or puff. (Page 1, col. 1, ll. 41-54).

FF-18. After removing excess caustic, the swollen sheets of Novak are ultimately put into a beater to separate the stock, and washed. (P. 1, col. 2, l. 54 – Page 2, col. 1, ll. 1-10).

FF-19. The stock was then put into a stock chest and run off a paper making machine in the usual manner (i.e. made into paper sheets) (P. 2, col. 1,, ll. 13-15).

FF-20. Novak's paper is said to be "very soft, open, and feltlike paper, very absorbent and easily saturated, capable of taking on more saturation than would be possible with ordinary kraft paper, it having an absorption four or five times greater" (Id. at ll. 15-20).

FF-21. Novak also notes that "it is not essential to use pulp in flat sheets" and that pulp may be used "in a looser form, as in coarse flakes or small broken sheets or similar distorted masses" which may be saturated and "pressed into a biscuit in situ and washed in the press if desired" (Id. at ll. 38-45).

FF-22. The Examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to

include a pulp as described by Novak into the absorbent product of Pociluyko. (Ans. at 4).

FF-23. According to the Examiner, doing so “would provide an absorbent product containing fluff pulp material that 1) is very soft, absorbent, and easily saturated; and 2) will not deteriorate in storage and can be conveniently shipped to [a] distant point in the same was as in the case of commercial wet pulp (Ans. at 4, (citing Novak, page 1, col. 1, lines 6-12 and page 2, col. 2, lines 21-26)).

II. The Argument on Appeal

i) The Appeal Brief Arguments

The Appellant urges that the Examiner has not established the obviousness of the claimed subject matter because “neither Pociluyko nor Novak suggest that the Novak pulp would be suitable for use in the claimed absorbent composites.” App. Br. at 8.

First, we observe that teaching, suggestion, or motivation is not a strict requirement, although a reason for making the combination must be given. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

However, we note that in this instance there does exist adequate reason to make the combination as proposed by the Examiner. The Examiner expressly noted that Novak’s pulp material would provide an

absorbent product containing fluff material that is very soft, absorbent, and easily saturated. A major point of making the Novak material is to increase the absorptive capacity of the pulp product, a side benefit is that it is soft. In its state at FF-18, extracted, beaten, and washed, the Novak pulp is a pulp which may be fluffed for use in an absorbent core. Accordingly, we are not persuaded by this first argument.

The Appellant next urges that Novak's pulp is a wet-laid felt and not a fluff material. (App. Br. at 8). While we agree that the working example of Novak is indeed a wet-laid felt paper, and Novak's goal is to create a more absorptive paper, the Appellant is too narrowly reading and overly limiting the description of Novak.

Novak must be read in the light of the knowledge of one of ordinary skill in the art. Novak discusses as an additional object "to use commercial cellulose pulps now on the market and to modify them in such a way that the pulp will not deteriorate in storage and can be easily handled and shipped" (P. 1, col. 1, ll. 12-16). Novak also contemplates pressing the material into a biscuit and washing instead of flat sheets (P. 2, col. 1, ll. 38-45). Further, Novak states any kind or grade of commercial cellulose pulp can be modified, so long as it is of cellulose fibers in a slightly coherent mass characterized by being *suitable for* rebating out and forming into paper. (P.

2, col. 2, ll. 12-21). “Suitable for” does not limit the description to only a wet laid felt paper process.

While Novak is principally directed to the manufacture of an improved absorbent paper by treating its pulp in caustic, one of ordinary skill in the art is taught that processing the pulp has the benefit of increasing absorbency and making a paper product softer. We see no error in the Examiner’s conclusion that one of ordinary skill in the art would have had reason to use this pulp as a fluffed pulp in an absorbent product such as Pociluyko.

The Appellant next urges that one could not substitute the felt paper of Novak for the fluff material of Pociluyko because the combination would not contain fluffed pulp. (App. Br. at 9).

This argument assumes (1) that one of ordinary skill in the art is without any skill at all and (2) that Novak must be bodily incorporated into Pociluyko. Neither assumption is correct.

First, the Examiner noted that it was the *pulp* of Novak, not the final paper product, that would be used in Pociluyko. Second, one of ordinary skill in the art would know not to make the final paper product from the pulp if a fluffed material was called for. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR*, 127 S.Ct. at 1742, 82

USPQ2d at 1397. One with ordinary skill in the art is presumed to have skills apart from what the prior art references explicitly say. See *In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985).

The Appellant urges that “if the invention were obvious as the Examiner has concluded, it would not have taken 70 years for Novak’s caustic extracted pulp felt to be fluffed and incorporated in the presently claimed absorbent composite.” (App. Br. at 9).

First, this is simply attorney argument, not evidence. Novak’s teaching of the pulp treatment is what is relied upon, not only the felt produced thereby alone.

Second, this argument is misdirected. The use of fluffed pulp has been well-known in the absorbent article art (see Pociluyko’s description of use of fluffed pulps generally). Indeed, in the opening pages of its brief, the Appellant urges that it has been conventional to use chemical crosslinking to increase the stiffness of the wood fiber pulp fibers in the production of absorbent devices which contain wood fiber pulp, so that a fiber matrix made from them retains its bulk and pore volume when wet, thereby enhancing its absorbency (App. Br. at 6, (citing Specification at page 2, line 16 to page 3, line 10)).

That the Examiner relied upon this particular piece of art, instead of another more recent one, does not mean that it took the art 70 years to arrive at the Appellant's claimed subject matter.

The Appellant's last identified argument is that the prior art previously relied upon (Chatterjee) teaches away from the claimed subject matter. App. Br. at 9. However, no actual argument is presented on this point and we will not presume to assume what that argument might have been.

Accordingly, the Appellants' opening brief does not persuade us of error.

ii) The Reply Brief

The Appellants' Reply Brief ("Reply") raises some procedural issues regarding this appeal.

First, there is substantial discussion about the ongoings in appeal 2005-2682. The claims of that appeal, and the record of that appeal, differ from this one. The outcome of that appeal, while useful in an informative sense, is not binding on the outcome of this appeal.

Second, there is discussion of certain results which are said to be superior to the conventional fluff pulp. (Reply at 6). These results are supplied in support of the Appellants' position that it was a surprising

discovery that one could avoid the use of chemically crosslinked wood fiber pulp. (Id.). We are told that the Appellant had no reason to provide evidence of nonobviousness in the present appeal because the Examiner's rejection was "fully overcome by the arguments submitted in Appellants' briefs" (Reply at 5) and if we do not reverse, we should remand for the consideration of the results.

This argument is without merit.

There is a time and a place to put forth evidence of unexpected results. The time is when the issue is joined, during prosecution or at the latest in the Appeal Brief. Indeed, the appellants argued in their opening brief:

Prior to the present invention, it was not believed to be possible to achieve the absorption, insult (or re-wetting), liquid retention, softness and pad integrity of modern absorbent personal hygiene devices without employing chemically crosslinked wood fiber pulp. Chemically crosslinked wood pulp fiber has increased the wet stiffness which prevents wet fiber collapse, thereby enhancing absorbency. (Specification, page 3, lines 3-9). The Specification of the present application at page 2, lines 16 to 22 references several prior patents directed to the use of chemically crosslinked wood fiber pulp in absorbent personal hygiene articles. The previously cited art of record, Chatterjee, is another such example. The present invention surprisingly discovered that by employing wood fiber pulp according to the invention, an absorbent core with desirable absorbency properties for use in personal hygiene devices could be formed without chemically crosslinked wood fiber pulp. The avoidance of chemically crosslinked wood fiber pulp was the expressed objective of the present invention. (App. Br. at 5, citing Specification, p. 1, lines 6-12).

The issue of whether wood fiber pulp as claimed had superior properties and presentation of any superior results (especially those already in the record) should have been addressed in the opening brief. It was not.

Arguments must be made in the brief. *Kaufman Company, Inc. v. Lantech, Inc.*, 807 F. 2d 970, 973 n., 1 USPQ2d 1202, 1204 n. (Fed. Cir. 1986); *McBride v. Merrell Dow and Pharmaceuticals, Inc.*, 800 F.2d 1208, 1210-11 (D.C. Cir. 1986) (“We generally will not entertain arguments omitted from an appellant’s opening brief and raised initially in his reply brief Considering an argument advanced for the first time in a reply brief, then, is not only unfair to appellee, . . . but also entails a risk of an improvident or ill-advised opinion on the legal issues tendered.”)

Consequently, we decline to consider this late argument or the evidence it references.

CONCLUSION

The rejection of claim 104 under 35 U.S.C. §103(a) over the combination of Pociluyko and Novak is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

rvb

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